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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,107

03/17/2004

John A. Clark

HAMM 1010 PA

5298

7590

01/12/2007

Jill L. Robinson  
95 Shuey Drive  
Moraga, CA 94556

EXAMINER

JOHNSON, VICKY A

ART UNIT

PAPER NUMBER

3682

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/12/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/803,107

Applicant(s)

CLARK

Examiner

Vicky A. Johnson

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5, 9-12, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith (US 6,663,129).

Smith discloses an adjustable shift lever comprising: a shift tip (10) comprising a first end comprising a knob portion (30); and a second end opposite the first end (see Fig 6), and connected to the knob portion, wherein the second end is connected to two substantially parallel wing portions (13) adapted to fit over a cooperating portion of a motorcycle shift arm (14); a fastener assembly (16,19) for connecting to at least one of the wing portions and for securing the shift tip to the shift arm (see Fig 2); and a shim

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(well known) adapted for placement between the cooperating portion of the motorcycle shift arm and at least one of the wing portions.

Re claims 2-4, the use of more than one shim to mount a grip is well known.

Re claim 5, the knob portion defines a central axis running between the first end and the second end, and wherein the fastener assembly is offset a selected distance from the central axis (see Fig 2).

Re claim 9, each of the wing portions is connected to the second end by a slanting member (see Fig 2).

Re claim 10, each of the wing portions forms a hole adapted to accept the fastening assembly (see Fig 2).

Re claim 11, each of the wing portions forms a hole adapted to accept the fastening assembly; and wherein each hole defines a centerpoint; and wherein each centerpoint is offset the selected distance from the central axis (see Fig 2).

Re claim 12, the fastener assembly is offset a selected distance from the central axis (see Fig 2).

Re claim 16, each of the wing portions is connected to the second end by a slanting member (see Fig 2).

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Re claim 17, each of the wing portions forms a hole adapted to accept the fastening assembly; and wherein each hole defines a centerpoint; and wherein each centerpoint is offset the selected distance from the central axis (see Fig 2).

Re claim 18, each of the wing portions forms a hole adapted to accept the fastening assembly; and wherein each hole defines a centerpoint; and wherein each centerpoint is offset the selected distance from the central axis (see Fig 2).

Re claim 19, a shim adapted for placement between the cooperating portion of the motorcycle shift arm and at least one of the wing portions and wherein the shim is selectably placeable in one of at least two positions (well known).

Re claim 20, the knob portion defines a central axis between the first end and the second end, and wherein the fastener assembly is offset a selected distance from the central axis (see Fig 2).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-8 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (US 6,663,129).

Smith discloses the device as described above, but does not disclose selected distance is at least 5 mm, 10 mm, or 15mm.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to determine the optimum or workable distance, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable values involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

3,667,315	Polly, Sr.	(shim)
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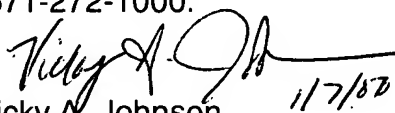
6,615,687	Bendetti et al	(shim)
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vicky A. Johnson whose telephone number is (571) 272-7106. The examiner can normally be reached on Monday-Friday (7:00a-3:30p).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on (571) 272-6217. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Vicky A. Johnson  
Primary Examiner  
Art Unit 3682  
11/7/07